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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,469	01/30/2004	Sang-on Choi	Q79516	3608
23373	7590	06/27/2006	EXAMINER	
SUGHRUE MION, PLLC			TO, TUAN C	
2100 PENNSYLVANIA AVENUE, N.W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20037			3663	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,469	<b>Applicant(s)</b> CHOI ET AL.	
	<b>Examiner</b> Tuan C. To	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 1-8 upon the elected Group I, species A, species "key", species "light emitting diode", in the reply filed on 12/05/2005 is acknowledged. The traversal is on the ground(s) that the restriction requirement is not proper, and that the claims are not directed to independent inventions. The applicant further argues that there is no burden on the examiner.

This is not found persuasive because the following:

MPEP 808 cites the reasons for insisting upon a restriction requirement. The examiner not only showed separate classification but also the reasoning why said groups were restrictable (i.e, combination/subcombination and process/apparatus). Clearly, a burden exists when more than one invention is claimed and requires numerous class/subclass searches.

The requirement is still deemed proper and is therefore made FINAL.

An action on claims 1-8 follows:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

Art Unit: 3663

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8 are rejected under 35 U.S.C. 102 (e) as being anticipated by Hasebe et al. (US 20030103002A1).

With respect to claim 1, Hasebe et al. teaches a portable device/method (Hasebe et al, Figure 3) for indicating a direction to a specific location. For example, its display shows an arrow (15) indicating the direction of Mecca (Hasebe et al, figure 3; page 3, paragraph 0049). Hasebe et al. teaches that the portable device includes an input unit, which is the input section (8) (Hasebe et al, figure 3, input section 8).

Hasebe et al. further teaches a geomagnetic sensor for detecting an azimuth (Hasebe et al., abstract).

Hasebe et al. further teaches a storage unit (Hasebe et al, figure 2, 16).

Hasebe et al. teaches a display (9) that includes an arrow indicating a direction to a specific location, and that in the second embodiment of the patent, the display also shows an orientation of the portable device and the specific locations (Hasebe et al, page 4, paragraph 0057).

Additionally, figure 1 of Hasebe et al. shows that the processor (1), which is the claimed control unit, upon transmission of the direction searching command from the input unit (8) (Hasebe et al, figure 3) indicates a direction to a specific location and the orientation of the portable device based on the detected geographic direction from the geomagnetic sensor (11) (Hasebe et al, figure 1, geomagnetic sensor 11).

With regard to claim 2, the input unit (8) as disclosed in Hasebe et al. comprises a key (see figure 3, input 8).

Art Unit: 3663

With regard to claim 3, Hasebe et al teach that the portable unit produces the music/or announcement when the direction of the antenna (2a) substantially matches the direction of Mecca, which is a specific location during a search (Hasebe et al., page 4, paragraph 0057).

With regard to claim 4, the portable unit represented herein above comprises a speaker (Hasebe et al., page 4, paragraph 0063).

With regard to claim 5, the portable unit represented herein comprises a data transceiver (2) for communicating with a setup time informing server connected by a network, wherein the control unit (1) generates an alarm signal through the speaker (6a). The arrow (15) indicates the direction to a specific location. The indication of orientation of the portable device is also shown when the direction of the antenna (2a) substantially matches the direction of a specific location (Mecca) (see Hasebe et al., page 4, paragraph 0057).

With regard to claim 6, Hasebe et al. directs to the control unit (1) that display a screen (Hasebe et al., figure 3, screen 9; page 2, paragraph 0031, lines 13 and 14).

The statements of intended use or field of use, "for searching...", "for detecting...", "for storing...", "for indicating...", etc (see claims 1, 2, 5, and 6) clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re

Art Unit: 3663

Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 3663

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe et al. (US 20030103002A1) and in view of Feigen (US 20010041961A1).

With regard to claim 7, Hasebe et al. fails to disclose "current city information setup screen with a continent select menu and a major city menu for selecting a major cities belonging to the selected continent, as a submenu to the continent select menu".

The secondary reference to Feigen discloses a display screen for setting up the current city information on the first display when a mode for searching the direction to the specific location is selected through the input unit (see Feigen, figure 2). The display screen (200) shown in figure 2 displays a list of current city information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the display screen as taught by Feigen to the a portable terminal device of Hasebe et al. so that a user would be able to search over the screen a usable information regarding to a selected destination, and therefore having the advantage of selecting a best place to visit.

The statements of intended use or field of use, "for selecting..." clause is essentially method limitations or statements or intended or desired use. Thus, the claim as well as the statement of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re

Art Unit: 3663

Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

With regard to claim 8, as shown in figure 2 of Feigen, the "select", "cancel" buttons are considered to be the confirmation buttons as claimed.

### ***Response to Arguments***

In response to the applicant's arguments filed 12/05/2005, the examiner has revised the art rejection in which the references of Hasebe et al. and Feigen are applied.

### ***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.



Art Unit: 3663

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C. To', is written over a horizontal line.

Tuan C. To

June 13, 2006